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PR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,805	03/06/2002	Kunihiko Morizane	029430-497	1558
7590	01/28/2004		EXAMINER	
Robert G Mukai Burns Doane Swecker & Mathis PO Box 1404 Alexandria, VA 22313-1404			KRISHNAN, GANAPATHY	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/009,805	MORIZANE ET AL.
	Examiner	Art Unit
	Ganapathy Krishnan	1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,3,7-10 and 12-16 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 2, 3, 7-10 and 12-16 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) Interview Summary (PTO-413) Paper No(s). ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

The amendment file on October 7, 2003 has been received, entered into the record and carefully considered. The following information provided in the amendment affects the instant application as follows:

1. Claims 1, 4-6 and 11 have been cancelled.
2. Claims 2, 3, 7-10, 12 and 13 have been amended.
3. New Claims 14-16 have been added.

Claims 2, 3, 7-10, 12-16 are pending.

Claim Objections

Claims 2, 3, 7-10, 12 and 13 are objected to because of the following informalities:

Claims 2, 3, 7-10, 12 and 13 depend from a higher numbered claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Cancellations of claims 1, 4-6 and 11 and amendments to claims 2, 3 and 7-10 have overcome the rejections of claims 1-12 advanced in the previous office action. The following new rejections are made of record.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 7-10 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Formula (3) in claim 13 has valence problems. The structural formula as recited is incorrect. It is not clear what is being claimed. R₃ is defined as a hydroxyl group substituted with a hydroxyl-protecting group. It is not clear what this means.

Formula (3) in claim 14 has valence problems. The structural formula as recited is incorrect. It is not clear what is being claimed. The recitation “as defined above” is indefinite. In all occurrences, phrases referencing the meaning of a variable as defined in some alternative, preceding location, such as “above”, without distinct reference to the particular location of said meaning or definition, renders the claim(s) in which said phrase(s) appear indefinite. The reference to some alternative location for a definition is superfluous if the definition or meaning is already set forth in a claim or said definition or meaning is clearly set forth in an independent claim from which a claim depends. In all occurrences and under these circumstances, the phrases should be deleted from the claims as superfluous.

In claim 16 it is not clear what “carbon atom of either the methylene group of the alkyl amine” means. The recitation conveys the meaning that it is either the methylene group of the alkyl amine or something else, which is not recited in the claim. Clarification is needed.

Claims that depend from rejected base claims that are unclear/indefinite are also rendered unclear/indefinite.

Claim Rejections - 35 USC § 102

The rejections of claims 1 and 6 have been rendered moot by cancellation of these claims.
The anticipation rejection of claim 13 has been overcome by amendment.

Claim Rejections - 35 USC § 103

The rejections of claims 7-9 have been overcome by amendments to the claims and applicant's arguments.

Conclusion

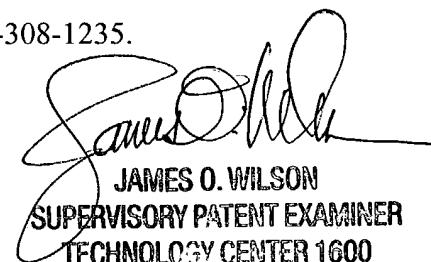
1. Claims 2, 3, 7-10 and 12-16 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ganapathy Krishnan whose telephone number is 703-305-4837. The examiner can normally be reached on 8.30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

GK



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600